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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,761	04/19/2006	Didier Letourneur	RN03086	5139

7590 01/16/2008

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EXAMINER	
DAVIS, BRIAN J	

ART UNIT	PAPER NUMBER
1621	

MAIL DATE	DELIVERY MODE
01/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/560,761	LETOURNEUR ET AL.	
	Examiner	Art Unit	
	Brian J. Davis	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-14 and 17-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-14 and 17-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

103 Rejections Withdrawn

The rejection of claims 15 and 16, outlined in the previous Office Action, under 35 USC 103(a), has been overcome by applicant's amendment. The amendment cancels the claims.

103 Rejections Maintained

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The rejection of claims 11-14 and 17-27 under 35 USC 103(a), outlined in the previous Office Action, is maintained for reasons of record. Applicant's amendment and arguments have been carefully considered, but are not persuasive.

With respect to applicant's arguments that the cited references (*Applied Catalysis, A: General* (1995), 133(2), p. 367-376; WO 2000027526; and WO 2000027525) do not recognize that the purpose of the hydrogenation may be purification, the examiner respectfully points out that such a teaching or recognition is not a requirement for a finding of obviousness. As was outlined in detail in the previous Office Action, the Office's position hinges upon the fact that the steps of the instant purification are *intrinsic* to the process of the prior art. (See also related case law: (1)

Claims are unpatentable where the prior art process per se of applying the chemical is the same, notwithstanding applicant's different purpose for application of the compound. *In re Kirby*, 40 USPQ 368; (2) The discovery of the cause of a problem is evidence of unobviousness, even though the solution may be obvious once the cause of the problem is known. *Eibel Process Co. v. Minnesota & Ontario Paper Co.* 261 USA 45, 43 S. Ct. 322, 67 L. Ed. 523 (1923)).

The only key limitation not present in the prior art, but present in the instant claim set, is applicant's statement that the purpose of the hydrogenation is purification. However, the prior art process *per force* performs this function even though the prior art does not recognize or acknowledge such a function.

With respect to applicant's arguments that the cited references (US 3,523,973;US 4,766,247; US 5,362,914; and US 5,364,971) do not teach the instant process, the examiner respectfully suggests that applicant has misinterpreted the Office's position.

The above references were cited to show that it is recognized in the art that various polyamines may be purified by catalytic hydrogenation. Given that, it then becomes obvious for one of ordinary skill to hydrogenate polyamines other than those of the listed patents with the reasonable expectation of success in their purification as well. (It is well established that expected beneficial results are evidence of obviousness of a claimed invention just as unexpected beneficial results are evidence of unobviousness. *In re Skoll*, 523 F.2d 1392, 187 USPQ 481 (CCPA 1975); *In re Skoner*,

517 F.2d 947, 186 USPQ 80 (CCPA 1975); *In re Gershon*, 372 F.2d 535, 152 USPQ 602 (CCPA 1967)).

Additionally, focusing specifically on US 3,523,973 (the basic patent of the rejection), once one of ordinary skill knows from the teachings of US 3,523,973 that an impurity, once separated and hydrogenated, yields more of the desired product, then for reasons of economy, one of ordinary skill would be motivated not to separate that impurity and just leave it in the reaction mixture and hydrogenate it there. Given that the reaction of interest is already a hydrogenation, this might translate into a slightly longer reaction time, etc. But again, as was outlined in detail in the previous Office Action, the instant claim set is obvious given the cited prior art.

Conclusion

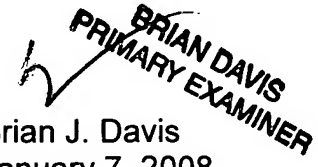
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached at 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brian J. Davis
January 7, 2008